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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/412,969	10/05/1999	JENNIE CHING	BC9-99-024	1335
23334	7590	03/10/2005	EXAMINER	
FLEIT, KAIN, GIBBONS, GUTMAN, BONGINI & BIANCO P.L. ONE BOCA COMMERCE CENTER 551 NORTHWEST 77TH STREET, SUITE 111 BOCA RATON, FL 33487			CHUNG, JASON J	
			ART UNIT	PAPER NUMBER
			2611	

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/412,969

Applicant(s)

CHING ET AL.

Examiner

Jason J. Chung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-33 have been considered but are moot in view of the new ground(s) of rejection.

The applicant argues on page 10, 1.131. affidavit heading of the response that the applicants affidavit overcomes the Yen reference. The examiner is unclear what Yen reference the applicant is referring to. The examiner respectfully requests the applicants to clarify what the Yen reference is.

### ***Response to Affidavit***

The affidavit filed on 10/7/04 under 37 CFR 1.131 has been considered but is ineffective to overcome the Zigmond reference.

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective **filing** date of the Zigmond reference. The Zigmond reference issue date is irrelevant since the effective filing date 4/20/1999 is prior to the application filing date 10/5/99.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Zigmond reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v.*

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*Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). The Zigmond reference filing date is prior to the application filing date.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Zigmond reference to either a constructive reduction to practice or an actual reduction to practice. The Zigmond reference filing date is prior to the application filing date.

The 37 CFR 1.131 declaration does not provide sufficient evidence for claims 3-6, 13-17, 20-23, 29-33 because facts and documentary evidence were not provided. See MPEP 715.07.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Picco (US Patent # 6,029,045) in view of Zigmond (US Patent # 6,571,392).

Regarding claim 1, Picco discloses receiving a play-list (local content transmission) and program content from a program provider, wherein the play-list is a list of instructions for rendering one or more multimedia segments into a multimedia presentation (column 6, line 57-column 7, line 32); the play-list is received by a conventional feed and/or a private feed (column 8, lines 23-39).

Picco discloses the play-list is based on a user's demographics (Picco: geographic region) assembled by the program provider (column 7, line 41-column 8, line 6).

Picco discloses the play-list contains pointers (local content profiles: column 8, lines 11-22) to indicate where each of the multimedia segments (local content) selected from a group of primary media sources is located (column 6, line 57-column 7, line 32).

Picco discloses the play-list contains a multimedia segment availability time when the multimedia segment in the play-list is to be received prior (private downloading: column 9, lines 10-39) to the time the multimedia segment is to be rendered column 9, lines 40-43).

Picco discloses receiving from the program provider 102 the multimedia segments (local content) required by the play-list (local content transmission) (column 6, line 57-column 7, line 32).

Picco discloses the local content (segment) is output to a television to be viewed by a viewer (column 12, lines 24-36), which meets the limitation on receiving multimedia presentation on the display by rendering the segments directed by the playlist.

Picco fails to disclose in response to one or more...removable medium. Zigmond discloses the information is not received, then the receivers receives the information from the Internet (column 6, line 14-column 7, line 7; figure 3), which meets the limitation on in response to one or more multimedia...media sources of an Internet. Zigmond discloses it is desirable to reliably receive and display information (column 2, lines 36-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Picco to have information sent from another source different from the first source in the event that information

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was not properly received as taught by Zigmond in order to reliably receive and display information.

Regarding claim 2, as disclosed in claim 1 rejections, Picco discloses the selected pieces of the local content are stored in the set top box (column 3, lines 14-30).

Regarding claim 3, Picco discloses the local content (segments) may be transmitted from a satellite system, a cable based system, or any other type (column 4, lines 51-65), which meets the limitation on receiving over a broadcast infrastructure.

Regarding claim 4, Picco discloses the database provides local content of advertisements (column 6, lines 57-61). Picco discloses the system could use a network such as the Internet to broadcast the targeted commercial (column 14, lines 58-67); a network has a server computer (program provider) that will have the database memory (computer readable medium) of local content to provide to the user.

Regarding claim 5, Picco discloses the local content (segments) may be transmitted from a satellite system, a cable based system, or any other type (column 4, lines 51-65), which meets the limitation on receiving over a telecommunications network.

Regarding claim 6, Picco discloses the system could use the Internet to broadcast the targeted commercial (column 14, lines 58-67).

Regarding claim 7, Picco discloses the local content (segment) is output to a television to be viewed by a viewer (column 12, lines 24-36).

Regarding claim 8, Picco discloses the local content (segment) are advertisements (column 12, lines 37-58).

Regarding claim 9, Picco discloses the live data streams may be digital (column 3, lines 7-10). Picco discloses the splicer determines which piece of local content to insert based on the size of the space in the programming data stream (column 10, line 58-column 11, line 13); digital data streams are segmented by bits, when the space for the local content is finished, the playlist will indicate for the local content to stop splicing and will switch to displaying the live data stream. The respective portions of the live digital data stream before and after the splicing also read on segments.

Regarding claim 10, Picco discloses the command and control data says where local content should be inserted (column 9, line 61-column 10, line 33).

Neither Picco, nor Zigmond discloses the time of rendering being the date. The examiner takes Official Notice that a date being a form of time is notoriously well known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Picco in view of Zigmond to have the instructions or the schedule for the time of rendering content comprise of a date for rendering content in order to provide a more specific time of rendering content.

Regarding claims 11-12, 14-17, the limitations in claim 11-12, 14-17 has been met in claims 1-6 rejections.

Regarding claim 13, as disclosed in claim 1 rejection, Picco discloses the scheduler provides control information comprising a content profile that indicates that households in certain geographic regions should store the content (column 2, lines 49-58 and column 7, line 61-column 8, line 6), which meets the limitation on grouping one or more clients receiving a playlist

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based on demographics of the viewers multimedia presentation and transmitting identical playlist to one or more clients based on the grouping.

Regarding claims 18-26, the limitations in claim 18-26 has been met in claims 1-9 rejections. Picco discloses the system could use a network such as the Internet to broadcast the targeted commercial (column 14, lines 58-67); a network has a server computer (program provider) that will have the database memory (computer readable medium) of local content to provide to the user.

Regarding claim 27, the limitations in claim 27 have been met in claim 10 rejection.

Regarding claims 28-33, the limitations in claims 28-33 has been met in claims 1-6 rejections. Picco discloses a system (column 4, lines 51-54).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.




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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason J. Chung whose telephone number is (703) 305-7362. The examiner can normally be reached on M-F, 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (703) 305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JJC



CHRIS GRANT  
PRIMARY EXAMINER